

RESPONSE AND REQUEST FOR RECONSIDERATION

In response to the Office Action of March 3, 2010 Applicants hereby request the Examiner to reconsider the claims in view of the present amendments and remarks. Entry of these remarks after final rejection, and consideration of this response, is requested because it is believed to put the claims in condition for allowance or, alternatively, to simplify issues for possible appeal.

This corrected amendment and response is filed in response the notice of non-compliant amendment mailed April 26, 2010. Claim 2 was incorrectly indentified as "original" when it clearly was "currently amended". Applicants have corrected this error and now resubmit the amendment and response.

The Amendments

Applicants have amended claim 34 by specifying the composition of claim 1. In addition, claim 34 has been amended to specify a range of 0.5 wt % to 15 wt % of the composition being technical the sulphur-free reaction product.

Support for this amendment is provided on page 5, lines 1-3 of the specification that states:

"Component (a) of the composition is often present on a weight basis at 0.01 to 40%, in another aspect at 0.5 to 40%, in yet another aspect at 0.75 to 20% and yet another aspect at 1 to 15% of the composition".

The selection of the upper and lower values of the range presently claimed is not considered added subject matter because page 27, lines 25 to 27 state:

"It is to be understood that the upper and lower amount, range, and ratio limits set forth herein may be independently combined."

Thus the range 0.5 wt % to 15 wt % is disclosed.

Claims 2, 4, 5, 23, 25, 28 and 37 have been amended to be dependent on method claim 34.

Applicants have cancelled without prejudice claims 1, 3, 26, 27, 32 and 33.

It is submitted that the amendments described above are fully supported by the application and do not add subject-matter.

The Examiner made a claim objection to claim 23 under 37 C.F.R. 1.121(c)(4)(i). The cancellation of the text as described above obviates this rejection.

The Examiner has rejected claims 26 and 27 under 35 U.S.C. 112, second paragraph. Since claims 26 and 27 have been cancelled, the rejections are obviated.

Remarks

The Examiner has raised a 35 U.S.C. 103(a) rejection to claims 1-5, 25-34, and 37 over Taylor (WO 01/56968) in view of Hoke (US 4,090,971).

The Examiner contends that Taylor describes a salixarate. The Examiner indicated that Taylor does not teach reacting salicylic compounds with an amine. The Examiner uses the disclosure of Hoke to prepare salicylamides useful as dispersants in lubricants or fuels. The Examiner states that it would have been obvious for one of ordinary skill in the art at the time of the invention to have used the salixarate of Taylor to prepare the salicylamides according to Hoke.

The Applicant contends that Taylor generically discloses salixarate compounds as is defined by claims 1-14 of Taylor chemistry in fuel compositions. The compound of Taylor is disclosed generically as disclosed for lubricants (see claims 15 to 22). However, claim 17 of Taylor and page 13, lines 18 to 20 explicitly disclose that the additive is present at 1-1000 ppm, or 5-500 ppm, or 5-200 ppm or 10-100ppm. The amounts explicitly taught by Taylor are representative of amounts of additive used in fuel compositions. This is also evident from the majority of the disclosure of Taylor. For example Examples 6-10 (see page 27, lines 8 to 18) disclose adding the additives at 6 mg/l to aviation fuel. Taylor has an in-depth disclosure on page 13, line 25 to page 20, line 25 relating to fuel compositions. Page 21, line 1 to line 16 further disclose the benefits of the additive in fuels.

The Applicant therefore submits that a person of ordinary skill in the art reading Taylor would be motivated to utilise the additive in an amount ranging from 1-1000 ppm. Furthermore, the person of ordinary skill would contemplate employing the additive in a fuel composition.

If a skilled person were to combine the disclosure of Taylor and Hoke as suggested by the Examiner any resultant combination would result in a composition comprising 1-1000 ppm of additive. In addition, given only limited disclosure of Taylor

towards lubricating compositions, a person of ordinary skill would not have the expectation that the compositions of Taylor could be used extended beyond 1000 ppm.

In contrast, the present invention has an additive treat rate of 0.5 wt % to 15 wt % of the composition of the claimed sulphur free reaction product. This means that the present invention requires at least about 5000 ppm of the product. This amount is at least five times that disclosed in Taylor. In addition, Taylor is silent on a method of lubricating an internal combustion engine. By combining the difference in treat rate and applying a lubricating composition to a particular method of lubricating an internal combustion engine, the present invention has unexpectedly found that the additives presently claimed provide antiwear performance. Since Hoke teaches towards dispersancy, Hoke is silent on antiwear. Thus by significantly changing the treat rate and applying the sulphur free reaction product in an internal combustion engine, the present invention has unexpectedly found that antiwear performance is obtained. This is neither taught, nor suggested by Taylor, nor Hoke. Consequently, combining Taylor with Hoke as suggested by the Examiner does not produce the present invention. In view of the remarks above, it is submitted that the present invention is unobvious over Taylor in view of Hoke.

For the foregoing reasons, it is submitted that the present claims are in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding Office Action. Therefore, an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the undersigned is suggested.

Any additional required fees, or any insufficiency or overpayment of fees, should be charged or credited to Deposit Account No. 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

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